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WELLS ST. JOHN P.S.
601 W. FIRST AVENUE, SUITE 1300
SPOKANE WA 99201

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APR 01 2004

OFFICE OF PETITIONS

In re Application of
Sujit Sharan et al.
Application No. 10/620,426
Filed: July 17, 2003
Attorney Docket No. MI22-2360
Title: PLASMA ENHANCED CHEMICAL
VAPOR DEPOSITION METHODS AND
SEMICONDUCTOR PROCESSING
METHODS OF FORMING LAYERS AND
SHALLOW TRENCH ISOLATION
REGIONS

DECISION ON PETITION

This is a decision on the "Petition to Establish Prior Receipt in the P.T.O. of Items Considered as Omitted by the P.T.O. – Response to 'Notice of Omitted Items,'" filed December 22, 2003, requesting that the above-identified application be accorded a filing date of July 17, 2003, with Figures 7 and 8 (seven and eight) as part of the original disclosure of the application.

The application was filed on July 17, 2003. However, on October 20, 2003, the Office of Initial Patent Examination (OIPE) mailed a notice stating that the application had been accorded a filing date, and advising applicants that the application appeared to have been deposited without Figures 7 and 8 (seven and eight).

With the instant petition, Petitioner has submitted a copy of Figures 7 and 8 (seven and eight), the petition fee, and a copy of the postcard receipt.

Petitioner asserts that Figures 7 and 8 (seven and eight) were included on filing. Petitioner is mistaken, in that the drawings submitted on filing do not match those which were submitted with the instant petition. The drawings submitted on filing bear the attorney docket number MI22-2360, and consist of four sheets. The sheet labeled "1/4" contains Figures 1-2, "2/4" contains Figures 3-4, "3/4" contains Figure 5, and "4/4" contains Figure 6. Figures 7-8 do not appear. The drawings submitted with the instant petition consist of four sheets, the sheet labeled "1/4"

contains Figures 1-2, the sheet labeled "2/4" contains Figures 3-4, the sheet labeled "3/4" contains Figures 5-6, and the sheet labeled "4/4" contains Figures 7-8. It is noted that the original application papers include a substitute drawing request; however, no drawings are present in the application other than those bearing the attorney docket number MI22-2360. Clearly, Petitioner's assertion that "a review of the originally filed specification shows that 4 sheets of drawings were submitted, those drawings include 4 sheets, Figs. 1-8¹" is incorrect.

Also, the postcard petitioner has submitted with the instant petition might have been able to establish that the application, as filed, included a copy of the prior application with four sheets of drawings and four sheets of substitute drawings, had it been better itemized². However, the portions which list "true copy of parent application including 22 pages of specification, claims, and abstract plus title page; drawings and declaration" and "substitute drawing request & 4 sheets of formal drawings (Figs. 1-6)" are insufficient to establish that the four sheets of substitute drawings were received. The items mentioned on the postcard, namely the four sheets of drawings containing Figures 1-6 (one through six) were received. Figures 7-8 (seven and eight), which do not appear on the postcard, were not received on filing. As such, it would appear that the postcard accurately reflects what was received in the Office on filing, and Figures 7-8 (seven and eight) are not among that which was deposited on July 17, 2003.

Furthermore, Petitioners do not explicitly state that Figures 7 and 8 (seven and eight) were constructively included on filing, through incorporation by reference, although the notion is implied. The Utility Patent Application Transmittal sheet indicates that the entire disclosure of the parent application (09/652,534) is incorporated by reference.

The Office allows an applicant to rely upon an incorporation by reference of a parent application when a portion of the child application has been inadvertently omitted. It is noted that the application transmittal letter identifies this application as a continuation of prior application No. 09/652,534, and specifically incorporated by reference the disclosure of the prior application. Section 201.06(c) of the MPEP sets forth, in part:

an applicant may incorporate by reference the prior application by including, in the continuation or divisional application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The incorporation by reference statement can only be relied upon to permit the entering of a portion of the prior application into the continuation or divisional application when the portion of the prior application has been inadvertently omitted from the submitted application papers in the continuation or divisional application. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuation or divisional application to include any subject matter in such prior application(s), without the need for

¹ Petition, page 1.

² The postcard receipt will not serve as prima facie evidence of receipt of any item which is not adequately itemized on the postcard. For example, merely listing on the postcard "a complete application" or "patent application" will not serve as a proper receipt for each of the required components of an application (e.g., specification (including claims), drawings (if necessary), oath or declaration and the application filing fee) or missing portions (e.g., pages, sheets of drawings) of an application if one of the components or portion of a component is found to be missing by the USPTO. Each separate component should be specifically and properly itemized on the postcard. Furthermore, merely incorporating by reference in the postcard receipt, the items listed in a transmittal letter will not serve as prima facie evidence of receipt of those items.

a petition provided the continuation or divisional application is entitled to a filing date notwithstanding the incorporation by reference.

If petitioner desires for the examiner to consider the missing page which was not submitted as part of the original disclosure, then petitioner may submit that page via an amendment. Any such amendment will, of course, be reviewed by the examiner for new matter³. The amendment is not new matter if the substance was a part of the disclosure of the prior application.

For these reasons, the petition under 37 CFR 1.53(b) is dismissed.

Figures 7 and 8 (seven and eight), submitted with the instant petition, will not be entered. Should petitioner wish for the page to be entered, an amendment must be filed.

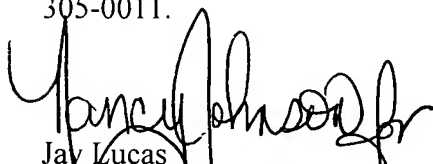
The original application papers will include only those application papers present on the date of deposit.

The petition fee of \$130.00 will not be refunded, as this petition was not necessitated by any error on the part of the Office.

The Application is being returned to the Office of Initial Patent Examination for further processing with a filing date of July 17, 2003, using only the application papers filed on that date.

After the mailing of this decision, the application will be forwarded to the Office of Initial Patent Examination for further processing.

Telephone inquiries specific to this matter should be directed to Attorney Paul Shanoski at (703) 305-0011.



Jay Lucas
Interim Supervisory Petitions Examiner
Office of Petitions
United States Patent and Trademark Office

³ See MPEP 608.02(a).